

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the Patent Application of:

TIMOTHY R. HAWES

Serial No.: 10/064,350

Filed: July 3, 2002

For: FENDER ASSEMBLY AND ADJUSTABLE MOUNTING BRACKET THEREFOR

Group Art Unit: 3632

Examiner: Frank Bennett Vanaman

Confirmation No: 9613

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REPLY BRIEF

This Reply Brief is in response to new issues raised by the Examiner in his Examiner's Answer in the above-identified Appeal. Appellants Reply Brief principally relate to the recent decision of the Supreme Court in *KSR International Co v. Teleflex Inc.* 127 S. Ct. 1727; 167 L. Ed. 2d 705; 2007 U.S. LEXIS 4745; 75 U.S.L.W. 4289; 82 U.S.P.Q.2D (BNA) 1385 (2007) (hereinafter "*KSR*") and the subsequent decision by the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences in the case of *Ex parte Smith* ____ USPQ2d ____ (2007), which applied the *KSR* decision to the facts of that Appeal. Appellants believe that the Examiner

has misconstrued the *KSR* and the *Smith* decisions in asserting obviousness of the claimed invention over the prior art.

In addition, the Examiner has introduced new issues with respect to the rejection of claims 31-39 as anticipated by Takahashi et al. and Appellants wish to respond to these new arguments presented by the Examiner.

35 U.S.C § 102 Anticipation

In the Examiner's paragraph (9), the Examiner has mischaracterized the Takahashi et al. reference as being a mounting bracket for a vehicle as having an elongated support arm (32) a length-adjustable link connection having first bracket portion (3) connected to the elongated arm and a second bracket portion adapted to be rotatably connected to a vehicle portion. The Takahashi et al. reference is in fact a connecting rod equipped with ball joints capable of adjusting the distance between the centers thereof. Appellant disputes the Examiner's characterization of the Takahashi et al. reference in terms of the claim language because it simply does not fit as set forth in Appellant's Appeal Brief.

In paragraph (10), entitled "Response to Argument," the Examiner has asserted that the Appellant has not specified a specific structural feature of the bracket, beyond the adaptability of mounting to a fender, which is not shown in Takahashi. The Examiner has ignored the interrelationship between the claimed bracket and the vehicle fender that is required by claims 31-39. In particular, the Examiner represents that the Takahashi et al. reference has all of the structural limitations in the claims and can perform all of the functions of the claimed invention in claims 31-39. In particular, the Examiner believes that one of the ball shanks in the Takahashi reference meets the limitation of an elongated support arm that can perform both the function of supporting the fender and is adapted to be attached to the fender. Whereas the threaded rod of Takahashi may be used to attach the Takahashi bracket to a fender, it would not perform the function of an elongated support arm to support the fender. The Takahashi et al. ball joint would not support the fender because the fender would rotate on the ball joint in multiple directions and would come to rest on the fender. For that matter, the ball joint at the other end of the Takahashi

connecting rod, if attached to a vehicle frame, would also result in collapse of the fender onto the vehicle tires. Thus, the Takahashi et al. connecting rod with ball joints is not capable of supporting a fender on a vehicle frame as claimed and thus does not anticipate claims 31-39.

35 U.S.C. § 103 - *KSR v. Teleflex* Analysis

The Examiner has cited the *KSR* decision in support of his obviousness rejection of combining the Mortvedt et al. reference with the Takahashi et al. reference. The Examiner is in error in believing that Appellant has applied a rigid rule of requiring the so-called "TSM" analysis to the rejection. Appellant believes that the Examiner has cited the *KSR* decision as a justification for applying hindsight application of the Takahashi et al. reference to the disclosure in Mortvedt et al. disclosure.

KSR did not change the law with respect to the standard of patentability under 35 U.S.C. § 103. It simply disagreed with the Federal Circuit's decision in *KSR* with respect to applying a rigid rule for an obviousness determination and thereby precluding any other analysis that is required by Supreme Court precedent. The Supreme Court did not abrogate a requirement for applying reasoning to a rejection under 35 U.S.C. § 103.

. . . Often, it will be necessary for a Court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn* 441 F.3d 977, 988 (CA Fed 2006) ("Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness"). . . .

KSR 82 USPQ2d at 1396. The Examiner's Conclusory Statements with respect to the combination of references are not reasons.

The important distinction of the claimed invention from *KSR* and *ex parte Smith* is that a vehicle fender mounting bracket has an additional degree of adjustment that is not found in the

prior art. In contrast, all the functions performed in the prior art in KSR and Smith were performed by the prior art references in the field of the claimed invention. The particular function of the ability to vertically adjust the position of the fender without moving the fender forward or rearwardly is not found in any of the references. Nor is the desirability to do so found in any prior art reference. Clearly, Mortvedt et al. does not disclose this feature and in fact teaches against this feature. Contrary to the Examiner's statement on page 5 of his Examiner's Answer (first partial paragraph), the angle of the Mortvedt et al. fender is fully adjustable without the Examiner's modification by the Takahashi et al. structure. See Mortvedt et al. column 3, lines 20-30.

The Examiner's reliance on and the Takahashi et al. reference to teach this function is misplaced. Takahashi has nothing to do with the adjustment of a fender or any other element for that matter for vertical adjustment without fore or aft adjustment. In the claimed invention, the extent of prior art adjustment is purely rotational of bracket plate 38 about an axis of bolt 42 and movement of the bracket plane 30 in a fore and aft position on the vehicle frame. There is no disclosure of a vehicle fender mounting bracket that is capable of mounting the fender for both rotational and a longitudinal adjustment of the bracket between the frame and the fender so that the bracket can be adjusted vertically without adjusting the fender in a translational, i.e. forward to rear direction. No prior art reference recognized the desirability of a mechanism for achieving these two functions.

In *KSR*, the invention related to a vehicle control pedal that performed the functions of movement in the fore and aft directions as well as a pivotally mounted pedal wherein a control signal is related to the pivotal position of the pedal regardless of the fore and aft position of the panel. Both of these functions for pedals were known. Teleflex merely combined the two known functions into a single pedal control. Nothing was new in the vehicle pedal art other than the combination of the two functions in a vehicle pedal.

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Ex parte Mary Smith is a similar case. The claimed invention brought two different known elements of the bookbinding art into a single claim. No new function was performed in the combination.

Contrasting these cases with Appellants claimed invention, no reference discloses the desirability of a fender mounting bracket that is length adjustable. In other words, the concept of a fender mounting bracket that gives height adjustability without fore and aft adjustment as well as fore and aft adjustment without changing the height of the fender is not disclosed in the prior art references.

In view of the foregoing, it is believed that *KSR* and *Ex parte Smith* do not support the Examiner's reconstruction of the claims by combining the Mortvedt et al. and Takahashi et al. references.

CONCLUSION

The reversal of the Examiner on all grounds is respectfully requested.

Respectfully submitted,

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